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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,312	07/26/2006	Nam-Chon Pack	4240-145	1925
23448	7590	08/19/2009	EXAMINER	
INTELLECTUAL PROPERTY / TECHNOLOGY LAW			KALLIS, RUSSELL	
PO BOX 14329			ART UNIT	PAPER NUMBER
RESEARCH TRIANGLE PARK, NC 27709			1638	
MAIL DATE		DELIVERY MODE		
08/19/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,312	<b>Applicant(s)</b> PAEK ET AL.
	<b>Examiner</b> RUSSELL KALLIS	<b>Art Unit</b> 1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 23 April 2009.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-35 is/are pending in the application.

4a) Of the above claim(s) 5 and 9-35 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4 and 6-8 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 26 July 2006 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of Group I claims 1-4, 6-8 and SEQ ID NO: 1 in the reply filed on 4/23/2009 is acknowledged. The traversal is on the ground(s) that all of the Groups possess a common special technical feature. This is not found persuasive because there is no special technical feature uniting the Groups because the special technical feature of a mutant stay green plant was taught in the art as indicated in the previous office action mailed 3/23/2009. Moreover, contrary to Applicants' assertion that all Groups require the SGR gene, the invention of Groups III, IV and V do not require any knowledge of the SGR gene in order to practice the invention as broadly claimed

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-35 are pending. Claims 5 and 9-35 are withdrawn. Claims 1-4 and 6-8 are examined.

***Drawings***

Figures 23-26 are poor reproductions and are not suitable for publication.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims are drawn to polynucleotides encoding an SGR gene having at least 60% sequence identity to amino acids 49 through 207 of SEQ ID NO: 30 from rice, vectors therewith and transformed plants thereof.

The claimed invention is not supported by an enabling disclosure taking into account the *Wands* factors. *In re Wands*, 858/F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988). *In re Wands* lists a number of factors for determining whether or not undue experimentation would be required by one skilled in the art to make and/or use the invention. These factors are: the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples of the invention, the nature of the invention, the state of the prior art, the relative skill of those in the art, the predictability or unpredictability of the art, and the breadth of the claim.

Applicants teach reduced SGR gene expression in *Arabidopsis* transformed with an *Arabidopsis* RNAi SGR silencing construct and a slight increase in the length of leaf greenness.

Applicants do not teach a delay in senescence.

The state-of-the-art is such that one of skill in the art cannot predict the physiological result from a mutation of a single component in a complex process. In the instant example, chlorophyll degradation was slowed or halted but the rest of senescence proceeded forward (see Park S. et al., The Plant Cell: May 2007; Vol. 19, pp. 1649-1664; on page 1650 in col. 2 4<sup>th</sup> sentence from the bottom and in Cha KW., et al. Theor. Appl. Gent. 2002; Vol. 104 pp. 526-532 se p. 531 in col 1 lines 14-28).

Given the lack of guidance in the instant specification, undue trial and error experimentation would be required for one of ordinary skill in the art to make and use the invention. Therefore, given the breadth of the claims; the lack of guidance and working examples; the unpredictability in the art; and the state-of-the-art as discussed above, undue experimentation would be required to practice the claimed invention, and therefore the invention is not enabled.

Claims 1-4 and 6-8 are rejected

Claims 1-4 and 6-8 are deemed free of the prior art given the failure of the prior art to teach or suggest an SGR encoding polynucleotide of SEQ ID NO: 1 and transformed plants thereof.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RUSSELL KALLIS whose telephone number is (571)272-0798. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Russell Kallis/  
Primary Examiner, Art Unit 1638  
August 14, 2009